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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,660	11/22/1999	EDWARD J. PETRUS		8939

7590                    06/17/2003

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[REDACTED] EXAMINER

PORTER, RACHEL L

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

3626

DATE MAILED: 06/17/2003

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20

Application Number: 09/444,660  
Filing Date: November 22, 1999  
Appellant(s): PETRUS, EDWARD J.

**MAILED**

JUN 17 2003

Edward J. Petrus  
Pro Se Appellant

**GROUP 3600**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4 April 2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

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**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-5.

Claims 6-10 have been canceled.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 10/17/03 has been entered.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Appellant's brief presents arguments relating to the propriety of the Final Rejection (Paper No. 8). This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. A petition regarding this matter has already been decided. (Paper No. 12)

The sole remaining issue on appeal is the rejection of claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Summerell et al (USPN 5,937,387) in view of Riley (USPN 5,976,568).

**(7) *Grouping of Claims***

The rejection of claims 1-5 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,937,387	SUMMERELL et al	8-1999
5,976,568	RILEY	11-1999

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 are rejected under 35 U.S.C. U.S.C. 103(a) as being unpatentable over Summerell et al (USPN 5,937,387) in view of Riley (USPN 5,976,568). This rejection is set forth in prior Office Actions, Paper Nos. 8 and 10, and is reproduced below.

***Claim Rejections - 35 USC § 103***

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Summerell et al (U.S. Patent No. 5,937,387) in view of Riley (U.S. Patent No. 5,976,568)

In reference to claim 1, Summerell et al teach a method for creating a dietary supplement profile for an individual comprising:

- completing a health questionnaire by an individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to health standard information (col. 11, lines 18-29)
- generating a computer-implemented dietary supplement profile based on the individual's health information (Figures 18-25)

Summerell et al teach a method and system for providing a dietary supplement profile for an individual in which information from an individual's questionnaire is compared to health standard information based on individuals of comparable age, gender and health risks. (col. 11, lines 18-29) Summerell does not specifically teach that the health standard information (i.e. risk factor data) to which individual's questionnaire information is compared includes standards required for optimal health (i.e. the recited "optimal health profile stored in a database") but Summerell does disclose a wellness factor array scale that outlines optimal physiological ages that can be achieved with consumption of "optimal levels" of certain nutrients and with changes to various other health factors. (Table 1) At the time of the Appellant's invention, it would have been

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obvious to one of ordinary skill in the art to modify the system/method of Summerell to compare the individual's questionnaire information to standards that help the individual attain optimal health and to store the optimal health data (i.e. the optimal health profile) in a database. One would have been motivated to do this to facilitate data retrieval and health data comparisons and to better assist the user in setting and progressing toward tailored fitness goals that improve overall wellness, as suggested by Summerell. (col. 6, lines 36-52)

Summerell teaches a system/method that obtains individual health data and compares this data to health standard information as explained above. Summerell also discloses a system/method for providing a listing of nutritional/dietary supplements and suggested adjustments to lifestyle habits based on the system's comparison to health standard information. (Figures 18-25) However, it is unclear if the system/method of Summerell adjusts for differences between the individual's health information when compared to an optimal health profile then generates a dietary supplement profile suggested for an optimal health profile.

Riley teaches a method that adjusts for differences in the individual's health profile compared to an optimal health profile and generates a dietary supplement profile based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40). Insofar as the generated dietary supplement formulations are optimized for each gender and for individuals with various lifestyle factors (col. 7, lines 64-col. 8, line 6), it is respectfully submitted that the presence of the "optimal health profile" for comparison is readily apparent in the method of Riley. At the time of

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the Appellant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Summerell with the teaching of Riley. As suggested by Summerell, one would have been motivated to do this to provide options that are user-specific and tailored to further assist a particular user in meeting individual goals (col. 6, lines 23-29)

Riley also teaches a method in which the dietary supplement plan includes vitamins, minerals, and herbs. (Table 3) Riley does not expressly disclose that the dietary profile(s) also include(s) enzymes and amino acids, but does teach that the supplement profiles may include other dietary or nutritional compounds. (col. 21, lines 35-40; col. 22, lines 31-38) At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Summerell in view of Riley to include amino acids and enzymes in the dietary supplement plan for an optimal health profile. As suggested by Riley, one would have been motivated to do this to further ensure adequate intake of nutrients needed for disease prevention and to optimize wellness for individuals with varying lifestyle factors and states of health. (col. 7, lines 33-39; line 65-col. 8, line 9)

In reference to claim 2, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al further teach a method wherein the step of comparing further comprises the adding information provided from a physical examination. (col. 5, lines 62-67) A physician can input test result data (e.g. the individual's blood pressure) into the system. The questionnaire information and physical exam information are compared to health

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standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile). (col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 24—blood pressure recommendations)

In reference to claim 3, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al further teach a method wherein the step of comparing further comprises adding information provided by laboratory studies. (col. 3, lines 19-39, col. 5, lines 62-67) The method disclosed by Summerell et al assesses individual wellness based on several risk factors, health parameters, and test results, including total and HDL cholesterol levels and white blood cell counts. It is respectfully these data items are results that are by laboratory studies. (i.e. blood work/ blood counts.)

The questionnaire information and laboratory information are compared to health standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile). (col. 3, lines 19-39, col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 23—cholesterol level recommendations)

In reference to claim 4, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al teach a method that also includes adding a list of commercially available products that provide the dietary supplements listed in an optimal health profile. (Figures 24-25) In addition to providing nutritional recommendations, the output

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of the Summerell system also details which products (e.g. fruits, vegetables, artificial vitamin supplements) provide suggested nutrients. It is respectfully submitted the listed food products and artificial nutritional supplements are commercially available products. Moreover, the products included in the list provide nutrients that are included for an optimal health profile (e.g. vitamin C, vitamin E) (as per Riley reference: see Table 3)

In reference to claim 5, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al also teach a method wherein the dietary supplement profile also includes adding recommendations for weight management. (i.e. a weight management plan) (Figure 24). The sample “recommendation details” in the figure suggest a weight loss target for individuals with certain health problems (e.g. high blood pressure) and also explain the health benefits of weight loss and weight maintenance.

#### **(11) Response to Arguments**

In the Appeal Brief filed 4 April 2003, the Appellant makes the following arguments:

- A. The Final Rejection (Paper No. 8) mailed 11 September 2002 is improper, and therefore not a Final Rejection.
- B. The Appellant’s invention and specification distinguish over the prior art, namely Summerell et al.
- C. The Examiner’s statement regarding features lacking in the primary reference, Summerell, nullifies an obviousness rejection under 103.

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- D. Summerell does not teach or suggest an individual dietary supplement plan.
- E. The Summerell and Riley combination reference is improper, and the Riley reference teaches away from the Appellant's invention.
- F. The Appellant argues issues regarding the withdrawn claim rejections under 35 U.S.C. 102.
- G. The grounds of rejection and motivations have not been clearly established and should be void because of "vagueness."

Response to Argument (A)

This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

Moreover, a petition regarding this issue has already been decided. The Appellant's arguments regarding the propriety of the Final Rejection have been fully considered and addressed in detail in the Advisory Action (Paper No. 10) and in the Response to the Appellant's Petition under 37 C.F.R. 1.181 (Paper No. 12).

Response to Argument (B):

The Appellant apparently argues that the instant application has features that distinguish the Appellant's invention over the prior art of record. In response to the Appellant's argument that the reference(s) fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e. "computer controlled feedback loops by which the consequences of an event send back data that

in turn modify that event in the future") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is respectfully submitted that the Appellant fails to properly consider the vast breadth of the chosen claim language, and apparently relies upon features described only in portions of the specification in an attempt to distinguish the invention over the prior art. The Examiner must search for and consider prior art based on how it reads on the invention as *the invention is claimed*.

While the Examiner acknowledges that the prior art of record may or may not include each limitation of the invention as *disclosed in the Appellant's specification*, Examiner submits the claimed limitations of the invention have been shown to be either fully disclosed or obvious over the art of record as explained the previous Office Actions provided to the Appellant. The Appellant apparently ignores the evidence given by the Examiner, namely, specific portions of each applied reference, express articulations of the combinations and motivations for combinations, and the scientific and logical reasoning of one skilled in the art at the time of the Appellant's invention, as provided in the previous detailed Office Actions.

Response to Argument (C)

In response to the Appellant's assertion that the Examiner statement regarding the prior art nullifies any obviousness rejection, the factual inquiries set forth in *Graham*

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v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Appellant has apparently taken the Examiner's statement out of the context in which it was intended. On pages 6-7 of the Final Rejection (Paper No. 8), the Examiner has stated that it is "unclear if the system/method of Summerell adjusts for differences between the individual's health information when compared to an *optimal* health profile then generates a dietary supplement suggested for an *optimal* health profile." However, this statement is intended to provide a determination of the scope of the primary reference and an assessment of differences between the prior art and the claims at issue, as required by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The primary reference, Summerell et al, does not specifically disclose adjusting for differences between the individual's health information when compared to an optimal health profile, as claimed by the Appellant.

The secondary reference, Riley was introduced to teach adjusting for differences in the individual's health profile when compared to an optimal health profile and generating a dietary supplement profile that includes various nutrients based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40). The dietary supplement plan in the system/method of Riley compensates

for (additional) nutrients that an individual may require due to various lifestyle factors and/or risk factors. Insofar as the generated dietary supplement formulations are optimized for each gender and for individuals with various lifestyle factors (col. 7, lines 64-col. 8, line 6), it is respectfully submitted that the presence of the "optimal health profile" for comparison is readily apparent in the method of Riley. At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Summerell with the teaching of Riley. As suggested by Summerell, one would have been motivated to do this to provide options that are user-specific and tailored to further assist a particular user in meeting individual goals (col. 6, lines 23-29)

Therefore, the Examiner's statement regarding the distinctions between the Summerell and the claimed invention does not nullify any obviousness rejection made under 35 U.S.C. §103. Rather, the statement is provided to meet the standards set forth by *Graham v. John Deere* to establish a *prima facie* case of obviousness. In the instant case, the evidence provided includes specific portions of each applied reference, express articulations of the combinations and the motivations for such combinations, and the logical reasoning of one skilled in the art at the time of the Appellant's invention. Moreover, it is noted that the motivations to combine the references applied in the claim 1 rejection are accompanied by select portions of the respective reference(s) that specifically support that particular motivation. Thus, the rejection of claim 1 is proper and should be maintained.

Furthermore, the Appellant's reliance upon the court decision in *Jones v. Hardy* is inapposite to the issues at hand. The Examiner did consider the claimed invention as a whole, as noted above, but was not able to find any patentable difference between the recited claims and the collective teachings of Summerell and Riley.

Response to Argument D:

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Summerell et al in view of Riley has been provided to address the limitations of claim 1. Summerell et al teach a system for providing a personalized health and fitness profile for an individual. The system also generates health recommendations for the user listing suggestions on nutritional supplements (e.g. vitamins and minerals) to take to improve the user's health. (i.e. dietary supplement plan) (see figures 18-25, especially 22-25) For instance, in Figures 23-25, the Recommendation Details provide information on dietary supplements, which is addressed to a specific individual user of the system (i.e. Bob Barker). Insofar as the recommendations provided by the system and method of Summerell include recommendations for vitamins and minerals from natural and/or synthetic sources (Figure 24), the Examiner submits that the system generates a dietary supplement plan.

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The secondary reference, Riley, was relied upon to teach adjusting for differences in the individual's health profile compared to an optimal health profile and generating a dietary supplement profile that includes vitamins, minerals, and herbs based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40). The dietary supplement plan in the system/method of Riley compensates for nutrients that an individual may require due to various lifestyle factors or risk factors and provides vitamins, minerals, and herbs. (Table 3)

Riley does not expressly disclose that the dietary plan/profile(s) also include(s) enzymes and amino acids, but does teach that the supplement profiles may include other dietary or nutritional compounds. (col. 21, lines 35-40; col. 22, lines 31-38) However, the test for obviousness is not whether the applied references specifically teach the same combination of a method of generating dietary supplement profiles recited by Appellant, *per se*. Rather, the issue is whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of the features as claimed. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Summerell in view of Riley to include amino acids and enzymes in the dietary supplement plan for an optimal health profile. As suggested by Riley, one would have been motivated to do this to further ensure adequate intake of nutrients needed for disease prevention and to

optimize wellness for individuals with varying lifestyle factors and states of health. (col. 7, lines 33-39; line 65-col. 8, line 9).

Response to Argument (E)

In response to the Appellant's assertions that the Summerell and Riley combination is improper, and that Riley reference teaches away from the Appellant's invention, it is noted that the passages upon which the Appellant relies, namely col. 2, lines 42-49 and lines 62-66, are part of the "Background" information and do not reflect the teachings disclosed by Riley throughout the reference as a whole. In their proper context, these passages have been provided to identify problems that existed regarding nutritional supplementation at the time of the Riley invention. Simply stated, these passages describe long-felt needs within the art that Riley intended to address with the disclosed invention, and are not a description of the Riley invention, *per se*.

The Appellant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to consider the teaching and suggestions of the Riley reference, as detailed in the Final Rejection (Paper No. 8). Contrary to the Appellant's assertion that the reference teaches away from the Appellant's invention, the Riley reference in particular, suggests that a principle purpose of the invention is to fulfill the need for ". . . a nutritional system which supplies the right amount of micronutrients at the right time to help prevent the problems commonly seen with vitamin supplementation . . ." (col. 4, lines 32-47). As

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such, it is respectfully submitted that the Appellant's reliance upon the decisions in *United States v. Adams* and *In re Fine* are moot.

The Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. While the Examiner acknowledges that the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

With respect to Appellant's reliance upon the court decisions within *In re Gordon*, *In re Vaeck*, and *In re Lee*, the Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the Examiner's position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, however, the Examiner respectfully notes that the motivations to combine the applied references used for the art rejection of claim 1 are accompanied by select portions of the reference(s) that support the motivations. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner.

Response to Argument (F):

The Appellant's arguments regarding previous rejections under 35 U.S.C. §102 are moot since none of the claims currently stand rejected under 35 U.S.C. §102. These rejections were withdrawn as necessitated by the Appellant's amendments filed improperly on 6/11/02 and properly on 6/24/02.

As such, it is respectfully submitted that the Appellant's reliance upon the *Carella v. Starlight Archery and Pro Lines Co.* decision is immaterial to the issues at hand.

Response to Argument (G):

The Appellant alleges that the issues of rejection and motivations for the applied combinations are vague, and that "the rejection by the examiner could be viewed as void for vagueness." The Appellant's assessment of the issues of rejection and the assertion that no clear issue regarding the claim rejections has been communicated is incorrect. The Final Rejection (Paper No. 8) was 13 pages in length and provided specific reasons for the objections to the amendments filed 6/11/02 & 6/24/02, as well as detailed rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph and 35 U.S.C. 103. The Examiner has also addressed the Appellant's arguments in the Final Rejection and in the Advisory Action mailed 11/18/02 in an attempt to further assist Appellant in understanding the Examiner's interpretation of the prior art as applied to the claimed invention. Furthermore, in a telephonic interview dated June 2002, the Appellant never indicated that there was any vagueness or a lack of clear issues in the case.

In fact, the Appellant's After Final response, received 10/22/02, does not indicate a lack of clarity in the Examiner's objections to the specification or rejections of the

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pending claims. At each stage of prosecution, the Examiner has provided detailed explanations of the formal issues and grounds of rejections that stand against the pending claims. Any changes made regarding the Examiner's positions, formal issues, and the grounds of rejections have been made only in response to amendments and corrections made to the specification and to the claims by the Appellant. It is respectfully submitted the Appellant simply disagrees with the Examiner's positions, which have been clearly outlined and explained in detail in each and every communication sent from the Patent Office with regard to the instant application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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June 13, 2003

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